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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,459	11/21/2001	Mariko Egawa	TOS-125-USA-D	2290

7590 11/20/2002
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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,459

Applicant(s)

EGAWA ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 13-16 and 20-37 is/are pending in the application.
- 4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-16 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/147,293.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the amendment filed September 3, 2002. Claims 1 and 13 have been amended.

Specification

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 17-33 have been renumbered 20-37. ***Election/Restrictions***

Newly submitted claims 32-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims did not include a method for measuring antioxidant properties of a composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-4, 13-16 and 20-37 are pending. Claims 1 and 13 have been amended. Claims 32-37 are withdrawn. The status of claims 1-4, 13-16 and 20-31 are as follows.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 13, 14 and 20-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egawa et al., Cigarette smoke induced lipid peroxidation and its oxidative effect on skin, 3rd ASCS Conference, Taipei, Taiwan, May 23, 1997, pages 271-277.

Egawa et al. disclose that the antioxidants ascorbic acid, glutathione, hypotaurine, thiotaurine and tannin prevent oxidation and inhibit the increase of chemiluminescence of human skin due to cigarette smoke. See entire document and specifically section 2-3-2 on page 272, 2-3-3 on page 273, the first full paragraph and the Discussion at page 274 and Figure 9 at page 276.

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Egawa et al. does not teach one composition comprising a combination of components as instantly claimed. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960). Therefore, absent evidence of unexpected results, the combination of antioxidants instantly claimed is not patentable over the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare a composition containing any combination of the antioxidants disclosed by Egawa et al. expecting to obtain a composition that would protect the skin from an increase in chemiluminescence and peroxidation from exposure to tobacco smoke.

Claims 3, 4, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egawa et al. as applied to claims 1, 2, 13, 14 and 20-31 above, and further in view of the abstract of JP 08119849 obtained from database CAPLUS on STN.

Egawa et al. teaches or suggests all of the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not teach the hydroxycarboxylic acids instantly claimed.

JP '849 discloses cosmetic skin care compositions comprising keratolytic agents such as citric and malic acid. JP '849 also discloses ascorbic acid.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of Egawa et al. and add citric and/or malic acid as taught by JP '849 for their keratolytic effects.

Response to Arguments

Applicant's arguments filed September 3, 2002 have been fully considered but they are not persuasive.

Applicant argues that the Egawa et al. reference is not prior art because it has a publication date of May 3, 1997, which is later than the filing date of the foreign priority documents in the instant application. Applicant is referred to MPEP §201.13 and 35 U.S.C. 119(a), enclosed herewith, which states that no patent will be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the actual filing date of the application in this country. The actual filing date of the instant application is November 23, 1998, the filing date of U.S. application 09/147,293. The publication date of the Egawa et al. reference is more than one year prior to the actual filing date of the instant application. Therefore, the Egawa et al. reference constitutes a 35 U.S.C. 102(b) bar on a patent for the invention.

The new grounds of rejection have rendered all other arguments moot.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
November 8, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200